

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Compunetix, Inc.

Serial No. 75373098

Ansel M. Schwartz for applicant.

Ann E. Sappenfield, Trademark Examining Attorney, Law
Office 112 (Janice O'Lear, Managing Attorney).

Before Seeherman, Quinn and Hairston, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Compunetix, Inc. to
register the mark ENSEMBLE for "equipment, namely,
videoconferencing bridges for use in displaying two or more
images simultaneously for videoconferencing."¹

The trademark examining attorney refused registration
under Section 2(d) of the Trademark Act on the ground that
applicant's mark, if applied to applicant's goods, would so

¹ Application Serial No. 75373098, filed October 14, 1997, based
on an allegation of a bona fide intention to use the mark in
commerce.

resemble the previously registered mark ENSEMBLE for "telecommunications services, namely, electronic and wireless transmission of messages, voice, and data; electronic messaging services, namely, the recording, storage and retrieval of voice and text messages; [and] providing access to a global computer network,"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

The examining attorney maintains that, in addition to the marks' being identical, applicant's goods and registrant's services are complementary. According to the examining attorney, the recitation of services in the cited registration is broad enough to include teleconferencing services, and applicant's "teleconferencing hardware" is likely to be used in conjunction with teleconferencing services. Further, the examining attorney asserts, applicant's goods are in the normal fields of expansion of registrant's services. In support of the refusal, the examining attorney submitted fifteen third-party registrations which show, according to the examining attorney, that entities have registered a single mark for

² Registration No. 2283712, issued October 5, 1999.

both telecommunications hardware and related telecommunications services. The examining attorney also submitted a dictionary definition of "ensemble."

The gist of applicant's argument is that, although the goods and services in this case fall under the general category of "telecommunications," this fact does not automatically mean that they are related for purposes of likelihood of confusion. Applicant contends that its bridges are used in videoconferencing where two or more images (connecting three or more parties) appear on the display; two-party calls would not utilize such goods because these calls would not need a videoconferencing bridge. Applicant indicates that its bridges cost over \$75,000 each. Applicant also points to the fact that there are different purchasers for the involved goods and services; registrant's services are bought by ordinary individuals who need to send messages electronically, whereas applicant's goods are directly bought by a purchasing agent for a company, generally a telecommunications service provider, after negotiating with one of applicant's salespersons. Applicant further states that the purchasers of its expensive bridges are sophisticated. According to applicant, there have been no instances of actual confusion despite three years of

contemporaneous use of the marks. Applicant submitted a product brochure.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The marks involved herein are identical. This factor obviously weighs in favor of a finding of likelihood of confusion.

We turn next to the second du Pont factor, that is, the similarity or dissimilarity of applicant's and registrant's respective goods and services. As has been often stated, it is not necessary that the goods and/or services of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and

activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and In re International Telephone & Telegraph Corp., 197 USPQ2d 910 (TTAB 1978).

The mere fact that applicant's goods and registrant's services fall under the broad category of "telecommunications" is an insufficient basis upon which to find that the goods and services are related for purposes of our likelihood of confusion analysis. See: Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992). Applicant's highly specialized videoconferencing bridge is distinctly different from registrant's particular telecommunications services that offer users the ability to send messages electronically to each other.

It is common knowledge that telecommunications have invaded virtually every facet of business and personal life in this country. Whether teleconferencing or videoconferencing, using a cell phone, e-mailing, IM-ing or otherwise, the use of telecommunications is ubiquitous in

all aspects of life, especially in business. Thus, we are not persuaded that a relationship exists between applicant's goods and registrant's services simply because each fits in the extraordinarily broad category of telecommunications.

Applicant's videoconferencing bridge, as shown by the product literature of record, is a specialized piece of equipment with a very distinct technical function, namely, to provide multi-image displays for videoconferencing. This equipment is used to provide continuous, real time video when conferencing three or more parties. According to applicant, the goods cost in excess of \$75,000 apiece, and are purchased through direct sales between the end user and applicant's salesperson, only after a period of negotiation.

A significant factor in our decision is not only the differences in the specific nature of applicant's goods and registrant's services, but the differences in classes of purchasers for these goods and services. Although the examining attorney repeatedly refers to a "consumer" being confused, no indication is ever given as to the identity of this "consumer" or as to what class this "consumer" belongs. Although registrant's services appear to be rendered to ordinary consumers, it is clear that

applicant's videoconferencing bridges are not purchased by these same consumers. As identified in applicant's application, videoconferencing bridges are not the type of goods purchased by ordinary consumers, a fact further confirmed by applicant. Rather, as indicated by applicant, its goods are sold to telecommunications service providers such as MCI and Sprint. Simply stated, the examining attorney failed to identify any overlap in prospective purchasers for the goods and services; indeed, based on this record, it would appear that there are no common customers for them.³

Further, at least insofar as applicant's goods are concerned, they are purchased after careful consideration by sophisticated and discriminating purchasers employed by telecommunications service providers. This factor supports our conclusion that confusion is unlikely to occur.

In this case, in an attempt to show a relationship between applicant's goods and registrant's services, the examining attorney made of record fifteen third-party registrations that show companies have registered their

³ We recognize that the individuals who buy the bridges for the telecommunications service providers would, of course, also be purchasers of telecommunication services inasmuch as virtually everyone has a cell phone or access to the Internet. However, such people are obviously sophisticated purchasers who would know that these goods and services do not emanate from the same entities.

marks for both telecommunications goods and services. Third-party registrations which individually cover a number of different goods and/or services and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

We do not find that this evidence is persuasive of a different result herein. As previously noted, the field of telecommunications is so vast that third-party registrations for goods and services in this general area are not sufficient to show that all telecommunications goods and services, and more particularly, applicant's videoconferencing bridges and registrant's telecommunications services, are related. In point of fact, not a single one of these registrations covers both the specific goods and services shown in the application and registration, namely, videoconferencing bridges on the one hand, and electronic and wireless transmission of messages, voice and data, electronic messaging services and providing access to a global computer network on the other. Further, a close review shows that few of the registrations cover videoconferencing goods and/or services, adding credence to applicant's claim that videoconferencing is a

niche market. Likewise, we do not find this evidence persuasive to show that applicant's goods are in the normal fields of expansion of registrant. As pointed out by applicant, videoconferencing is a unique area of extreme technical complexity which precludes a natural expansion for telecommunications entities.

Lastly, although certainly not dispositive, the fact that, during a three-year period of contemporaneous use of the marks, applicant has not heard of any instances of actual confusion, lends further support to our view that confusion is not likely.

Based on the record before us, we see the examining attorney's assessment of the likelihood of confusion as amounting to only a speculative theoretical possibility. We conclude that even when sold under identical marks, the differences between applicant's goods and registrant's services, and the differences in the prospective purchasers therefor, preclude a likelihood of confusion.

Decision: The refusal to register is reversed.